REMARKS

In the Office Action mailed on May 22, 2003, claims 1-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. (U.S. Patent No. 6,052,695) ("Abe") in view of Sheard et al. (U.S. Patent No. 6,208,345) ("Sheard"); and claims 10-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sheard in view of Walker et al. (U.S. Patent No. 6,301,701) ("Walker"). The foregoing rejections are respectfully traversed.

Claims 1-4 and 10-13 are pending in the subject application, of which claims 1 and 10 are independent claims.

Amendments to the Specification:

The Specification is amended herein to correct typographical errors.

Amendments to the Claims:

Claims 1, 2, 3, and 10 are amended herein to improve the form thereof. Claim 1 is further amended herein to recite "installing each of a plurality of software agents onto its own one of a plurality of servers, wherein each of the plurality of software agents retrieves at least one of the log files from its associated one of the plurality of servers, and wherein each of the plurality of servers is associated with one of the plurality of tiers." New claim 14 is added herein. Care has been exercised to avoid the introduction of new matter.

Support for the amendments to claim1 may be found in the Specification in paragraph 0017.

Rejections of Claims 1-4:

Cited References:

Abe discusses a plurality of layered servers (Abe, col. 14, lines 49-50). A plurality of terminals are connected to each of the servers (Abe, col. 30, lines 10-12). Each terminal may be a workstation or a personal computer, and performs dispatch and receipt of messages related to transactions between itself and the corresponding server (Abe, col. 30, lines 12-16). The servers have logs that accumulate in times series log data (updating history) based upon the updating commands that they respectively have issued (Abe, col. 30, lines 17-21).

Sheard discusses a statistics monitor module and an associated statistics log to monitor and track data as it moves through a data exchange system (Sheard, col. 15, lines 51-54). The statistics monitor module provides historical performance information on queues and historical information on system resource usage (Sheard, col. 15, lines 54-56). The statistics monitor module provides a means for logging and tracing a given application (Sheard, col. 15, lines 56-58). Logging reveals the state of the application at the time of an error, while tracing provides a description of all software events as they occur (Sheard, col. 15, lines 58-60). The tracing information may be used for tracking the application, state, and other related operations (Sheard, col. 15, lines 60-62). The tracing information may be used in conjunction with the logging information to determine the cause for an error since it provides information about the sequence of events prior to an error (Sheard, col. 15, lines 62-65). Sheard further discusses displaying throughput information on the various queues (Sheard, col. 24, lines 31-34).

Differences Between Claimed Invention and Cited References:

Although Abe discusses servers and connected terminals (Abe, col. 30, lines 10-12), the terminals in Abe are restricted to workstations or personal computers (Abe, col. 30, lines 12-16). Therefore, because workstations and personal computers are understood by those skilled in the art to be separate hardware from the servers to which they are connected, Abe does not disclose or suggest the features of the present invention, e.g., installing software agents onto servers.

Specifically, claim 1 of the subject application (as amended herein) "installing each of a plurality of software agents onto its own one of a plurality of servers, wherein each of the plurality of software agents retrieves at least one of the log files from its associated one of the plurality of servers, and wherein each of the plurality of servers is associated with one of the plurality of tiers." The Specification at paragraph 0017 further explains that the agents are software programs, or tests, that are resident on the servers. Because Abe does not disclose or suggest software agents or agents that are resident on the servers, claim 1 of the subject application (as amended herein) is patentably distinguishable over the cited references. The Applicants respectfully request that the Examiner withdraw the rejections thereto.

Lack of Motivation to Combine the Cited References:

In addition, the Examiner has not set forth a *prima facie* case of obviousness,

7

because the Examiner has failed to adequately assert the motivation to combine Abe and Sheard. Specifically, MPEP § 706.02(j) sets forth the contents of a rejection under § 103: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure" (emphasis in original).

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "'The factual inquiry whether to combine the references must be thorough and searching.'" In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Examiner has not presented any evidence why Abe and Sheard would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The Examiner's does not even assert that a motivation to combine Abe and Sheard exists. The Examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper

8

and must be withdrawn.

Dependent Claims:

In addition to being allowable based on their dependency, directly or indirectly, from allowable claim 1, dependent claims 2-4 recite patentably distinguishing features of their own. For example, claim 2 (as amended herein) recites that "the plurality of tiers comprises a web servers tier, a session servers tier, a transaction servers tier, and a database servers tier." Although the Examiner cites Abe as disclosing the same, the section of Abe that is cited by the Examiner, col. 29, lines 30-50, only discusses five servers, 81A-D; however Abe does not describe any of the five servers 81A-D as the web servers tier, the session servers tier, the transaction servers tier, or the database servers tier as the same is described in the subject application (see paragraphs 0011 to 0016 of the Specification). Therefore, dependent claims 2-4 should be allowable in addition to or separate from claim 1.

Rejections of Claims 10-13:

Cited References:

Sheard is discussed above. The Business Management view is used primarily to chart statistical analyses carried out by the business extension modules (Sheard, col. 24, lines 45-47). Double clicking on a component, such as a Business Analysis component, results in displaying of the charts of information trends and distributions associated with the Business Analysis component (Sheard, col. 24, lines 47-50).

Walker discusses a transaction tester that facilitates a rapid, efficient, and repeatable testing of the transactions associated with the application (Walker, col. 12, lines 47-49). Such transaction testing is performed in an automatic manner wherein the transaction tester creates, runs, and checks transaction tests using test data that is automatically generated from the definition of the transaction (Walker, col. 12, lines 49-54). The transaction tester reports test results in a current test report from the test data (Walker, col. 13, lines 24-26). The current test report displays the transaction behavior resulting from the execution of the transaction on the test data (Walker, col. 13, lines 26-28).

Differences Between Claimed Invention and the Cited References:

Claim 10 of the subject application (as amended herein) recites measuring business

9

performance data "comprising monetary volume." In contrast, although the Examiner cites Sheard as disclosing the same, the section of Sheard that is cited by the Examiner does not refer to monetary volume. Instead, Sheard only discusses a Business Management view and a Business Analysis component (Sheard, col. 24, lines 47-50). However, Sheard does not define Business Management or Business Analysis as being associated with monetary volume. In fact, the Business Management view that is illustrated in Figure 22 of Sheard clearly displays a tally of telephone subscribers in various area codes, but not anything relating to monetary volume.

Clearly, claim 10 of the subject application (as amended herein) is patentably distinguishable over the cited references. The Applicants respectfully request that the Examiner withdraw the rejections thereto.

Lack of Motivation to Combine the Cited References:

In addition, the Examiner has not set forth a *prima facie* case of obviousness, because the Examiner has failed to adequately assert the motivation to combine Sheard and Walker. (The legal standard set forth above, in regard to the lack of motivation to combine Abe and Sheard, is incorporated as if fully set forth herein) The Examiner has not presented any evidence why Sheard and Walker would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The Examiner's does not even assert that the motivation to combine Sheard and Walker exists. The Examiner cannot rely on the benefit of the combination without first supporting the motivation to make the combination. Such motivation does not appear anywhere in either of the references, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

Dependent Claims:

In addition to being allowable based on their dependency, directly or indirectly, from allowable claim 10, dependent claims 11-13 recite patentably distinguishing features of their own. For example, claim 11 recites that "the business performance data further comprises

10

financial data transacted by the e-commerce installation during a time period." Although the Examiner cites Sheard as disclosing the same, the section of Sheard that is cited by the Examiner, col. 17, lines 57-65, does not disclose or suggest "financial data." Therefore, dependent claims 11-13 should be allowable in addition to or separate from claim 10.

New Claim 14:

New claim 14 is added herein. New claim 14 recites "software agents." As discussed above, Abe does not disclose or suggest software agents. Therefore, new claim 14 is patentably distinguishable therefrom.

Withdrawal of the foregoing rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned

to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _____8·૨૨·૨ºº૩_____   By: _____

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12